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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
Q199-US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]
on _____

Application Number
10/810,081Filed
March 25, 2004First Named Inventor
WEST, Robert et al.

Signature _____

Art Unit
1795Examiner
BEST, ZacharyTyped or printed
name _____

Applicant requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.

This request if being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

Signature

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34. _____

12/22/2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 37 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in re application of:
ROBERT C. WEST
Serial No: 10/810,081

Filed: March 25, 2004

For: ELECTROLYTE INCLUDING
POLYSILOXANE WITH CYCLIC CARBONATE
GROUPS

Art Unit: 1795
Examiner: Best, Zachary P.

MS After Final
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

This communication is in response to the Final Office Action mailed on July 2, 2009. Independent Claims 1 and 49 are the only independent claims pending.

Rejection of Independent Claims 1 and 49 Under 35 USC 103

Independent claims 1 and 49 stand rejected as being unpatentable over U.S. Patent number 6,447,952 (Speigel) in view of U.S. Patent number 6,783,897 (Karg).

Independent claims 1 and 49 each recites “polysiloxane having a first backbone that includes one or more backbone silicons directly linked to a first side chain and one or more backbone silicons directly linked to a second side chain, the first side chains including a poly(alkylene oxide) moiety and the second side chains including a cyclic carbonate moiety.”

The side chains recited in Claims 1 and 49 are not cross-links. To see this, note that Independent claims 1 and 49 each recites that “the first side chain and the second side chain each terminating before linking the first backbone to a second backbone of a second polysiloxane.”

The pending rejection is based on the following reasoning:

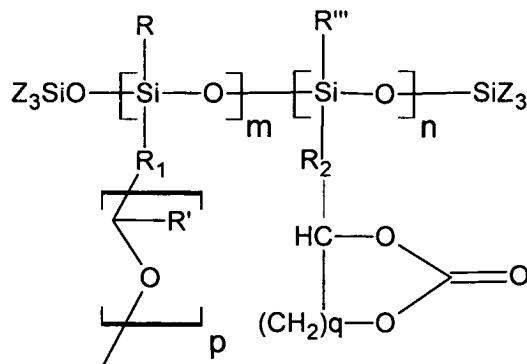
... it would have been obvious to ... crosslink the ... polysiloxane backbone of Speigel et al. with polyalkylene oxide groups ...

The “polyalkylene oxide groups” in this quotation are being analogized to the claimed poly(alkylene oxide) moiety. However, this quotation teaches that the “polyalkylene oxide groups” are included in the cross-link that is bolded in the above quotation. This teaching is in direct contrast to the claim requirement that the poly(alkylene oxide) moiety are included in side chains that are not cross links. As a result, the proposed modification does not result in the subject matter of claim 1 or of claim 49.

Rejection of Independent Claims 5 and 51 Under 35 USC 112

Dependent claims 5 and 51 stand rejected for failing to comply with the written description requirement. In particular, the Office Action argues that “the first side chain and the second side chain each terminating before linking the first backbone to a second backbone of a second polysiloxane” is not described in the specification in a way that conveys that the inventors had possession of this subject matter at the time the application was filed.

Claim 5 and 51 each limits the polysiloxane recited in an independent claim to a particular formula. For instance, claims 5 and 51 each limits the polysiloxane to the



following structure: This exact structure is disclosed in paragraph 10 and 21 of the specification. As a result, the Applicant was clearly in possession of the polysiloxane of claims 5 and 51 at the time of filing.

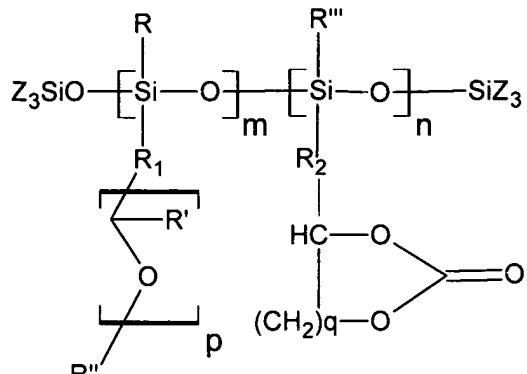
Rejection of Independent Claims 1 and 49 Under 35 USC 112

Independent claims 1 and 49 also stand rejected for failing to comply with the written description requirement. These claims stand rejected for the same reason as claims 5 and 51.

Substituents on the backbones of polymers include side chains and cross-links.

The prior Office Action indicated that the recited side chains included cross-links.

However, the specification presents an example of the claimed polysiloxane in Formula I:



Observation of Formula I shows that the first and second side chains are not cross links. As a result, the Applicant amended claims 1 and 49 to indicate that the polysiloxane is not a cross link. For instance, the Applicant amended these claims to recite that “the first side chain and the second side chain each terminating before linking the first backbone to a second backbone of a second polysiloxane.”

The support for the claim amendment can be found in paragraphs 9-10.

Paragraph 9 teaches a polysiloxane that includes “first side chains (that) include a poly(alkylene oxide) moiety and … second side chains (that) include a cyclic carbonate moiety.” Paragraph 10 then presents an example of the polysiloxane described in paragraph 9. In the example polysiloxane of paragraph 10, each of the sidechains terminates before linking the illustrated polysiloxane to another polysiloxane exactly as is claimed. Accordingly, the Applicant was in possession of the subject matter of claims 1 and 49 at the time of filing.

CONCLUSION

The Examiner is encouraged to telephone or e-mail the undersigned with any questions.



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